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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 24

Application Number: 09/087,552
Filing Date: 05/29/98
Appellant(s): Jeffrey C. Hawkins

Van Mahamedi
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 03/24/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

Claims 17-18, 28-29 and 33-43 are rejected.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 17-18, 28-29 and 33-43 stand or fall together. Appellant's brief includes a statement that group of claims 17-18, 28-29 and 33-37 stand or fall together, claims 38-42 stand or fall together, claim 43 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal

5,673,322	Pepe et al	03/22/96
6,173,316	De Boor	04/08/98

5,727,159	Kikinis	04/10/96
6,144,997	Lamming et al.	06/21/95

(10) Grounds of Rejection

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 43 recites "the display is contact- sensitive and wherein the processor receives user input by detecting contact to the display".There is no disclosure in the specification as originally filed of a contact- sensitive display and of the processor receives user input by detecting contact to the display. The specification discloses a conventional computer with a transceiver card (p. 5, lines 19-20).

*** Claim 34 did not include in amemdment***

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 17-18, 28-29,33 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al [U.S. Pat. No. 5,673,322] in view of De Boor et al. [US. Pat. No. 6,173,316].

As to claim 17, Pepe discloses a method for accessing data over a network using a wireless device, the method comprising:

-receiving a user input (col. 5; lines 53-61).

-in response to the user-input, executing the application to generate a compressed query (Fig. 5, col. 11, lines 35-42, col. 12, lines 33-39).

-sending the compressed query to proxy server external to the wireless device to cause the proxy server to request data from an Internet site (col. 6, lines 21-24);

-receiving a compressed response from the proxy server, the compressed response including data from the Internet site (col. 6, lines 26-29); and

-executing the application to process the compressed response in order to cause the data from the Internet site to be rendered on the wireless device from the compressed response (col. 8, lines 13-15).

Pepe does not disclose executing a wireless application on the wireless device.

DeBoor discloses a method to provide a wireless communication device with a markup language machine interface. The various configurable parameters of the wireless communication device accessible via a config protocol. The wireless communication device setting are adjusted using form gadgets to specify the possible values for each setting (col. 26, lines 27-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use DeBoor's teachings to modify Pepe's method by using a wireless application in the wireless device in order to achiever a compact, portable, hand held wireless device with improved navigational method.

As to claim 28, refer to claim 17 rejection for their common features. DeBoor further discloses a computer readable medium in a wireless device (Fig. 1).

As to claim 18, De boor further discloses wherein the method further includes:

-displaying a list of wireless applications on the wireless device (col. 11, lines 35-50); and where receiving a user input includes:

-receiving a user selection of the wireless application from the list of wireless applications displayed on the wireless device (col. 11, line 63-col. 12, line 3), and

-in response to the user selection, displaying a query form to allow a user to enter the user input (col. 30, lines 32-53).

As to claim 29, refer to claim 18 rejection for their common features. DeBoor further discloses a computer readable medium in a wireless device (Fig. 1).

As to claim 33, Pepe further discloses wherein executing the wireless application to generate a compressed query includes generating the compressed query in transport protocol (CTP) [Fig. 5, shows the local proxy on user's terminal generates a query in a compressed transport protocol (col.5, lines 54-57, col. 6, lines 1-9)].

As to claim 35, Pepe further discloses wherein executing the wireless application to render the data includes executing the application to use the compressed response without converting the compressed response to another protocol [Fig. 5 shows the local proxy on user's terminal receives a compressed response in transport protocol from the remote proxy, the local proxy retrieves the data from the compressed response and returns it to the browser (i.e. without converting the compressed response to another protocol) (col. 8, lines 9-15)].

As to claim 36, refer to claim 33 rejection for their common features. DeBoor further discloses a computer readable medium in a wireless device (Fig. 1).

5. Claims 34, & 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al [U.S. Pat. No. 5,673,322] in view of De Boor et al. [US. Pat. No. 6,173,316] as applied to claim 17 above and 29 further in view of Kikinis [US. Pat. No. 5,727,159].

As to claim 34, neither Pepe nor De Boor discloses wherein executing the wireless application to generate a compressed query includes generating the compressed query in markup language (CML).

Kikinis discloses a hand held device that downloads data from a proxy server and reduce the size of files (col. 3, lines 19-30). The files are translated into an H-lite language to reduce it's size and display it (col. 7, lines 6-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Kikinis's teachings to modify the combined method of Pepe, and DeBoor by using a compact makeup language to fetch the data from the proxy server and display it in order to transform the files downloaded from the web into a form quickly and easily displayable by the wireless device and to minimize bandwidth requirements for the link and speeds transmission of data.

As to claim 37, refer to claim 34 rejection for their common features. DeBoor further discloses a computer readable medium in a wireless device (Fig. 1).

6. Claims 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis [US. Pat. No. 5,727,159] in view of Pepe et al [U.S. Pat. No. 5,673,322] and further in view of De Boor et al. [US. Pat. No. 6,173,316].

As to claim 38, Kikinis discloses,

a display (Fig. 2, item 33),

a wireless communication mechanism (col. 5, lines 1-5),

a processor (Fig. 2, item 25) configured to:

receive a user input entered through execution of the application (Fig. 4, line step 76).

communicate over a wireless medium, without use of a local proxy within the portable computer, with a proxy server that is external to the portable computer by (i) sending the query to the proxy server using the wireless communication mechanism and receiving a compressed response from the proxy server over the wireless communication mechanism; and (ii) receiving a compressing response from the proxy server over the wireless communication mechanism [Fig. 4 shows hand held unit 13 sends a request without using a local proxy in the unit 13 (Fig. 2) via a satellite link to a proxy server. The proxy server retrieves the HTML file and translate it to a form useable by hand held unit, a 60k/70k JPEG file becomes a 2k/4k bit map (col. 7, lines 17-24), i.e compress the data and send it to the user].

Kikinis does not disclose,

execute a wireless application,

generate a compressed a query using the wireless application;

execute the wireless application to process the compressed response to cause the data from the Internet site to be rendered on the display from the compressed response.

Pepe discloses an interface between a computer and the Internet that communicate using wireless modem and generate a compressed query (Fig. 5, col. 11, lines 35-42, col. 12, lines 33-39).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis according to Pepe's teachings by compressing the user's query sent to the

remote proxy in order to reduce information density and minimizes bandwidth requirement of the wireless link.

Pepe does not disclose,

execute a wireless application,

execute the wireless application to process the compressed response to cause the data from the Internet site to be rendered on the display from the compressed response.

DeBoor discloses a method to provide a wireless communication device with a markup language machine interface. The various configurable parameters of the wireless communication device accessible via a config protocol. The wireless communication device setting are adjusted using form gadgets to specify the possible values for each setting (col. 26, lines 27-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use DeBoor's teachings to modify the combined system of Kikinis and Pepe by using a wireless application in the wireless device in order to achiever a compact, portable, hand held wireless device with improved navigational method.

As to claim 39, refer to claim 18 rejection.

As to claim 40, refer to claim 33 rejection.

As to claim 41, refer to claim 34 rejection.

As to claim 42, refer to claim 35 rejection.

7. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis [US. Pat. No. 5,727,159] in view of Pepe et al [U.S. Pat. No. 5,673,322] in view of De Boor et al. [US.

Pat. No. 6,173,316] as applied to claim 35 above and further in view of Lamming et al. [US. Pat. No. 6,144,997].

As to claim 43, [as best understood by the Examiner] Kikinis discloses that the wireless portable device is a PDA (col. 3, lines 33-35). Kikinis does not explicitly disclose wherein the display is contact- sensitive and wherein the processor receives user input by detecting contact to the display.

Lamming disclose a system of workstation coupled to portable devices carried by users. As shown in Fig. 2, screen so is a touch screen, user input by means of a finger tip.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Lamming's teachings to modify the combined system of Kikinis, Pepe, De Boor by using a touch screen display on hand held device that receives input from the user by touching the screen in order to reduce the size of portable hand held device by incorporating the input means in the display.

(11) Response to Argument

Applicant alleges that "All the claims group I: 17-18, 28-29, and 33-43 basically claim wireless application that receives wireless input, and that generates a compressed query from the wireless input [,]" (p. 6, line 12-p.7, line 4).This is not persuasive argument. Firstly, the Examiner can not find anywhere in the claims that the wireless application that receives a wireless input, and that a compressed query is generated from the wireless input. Secondly, it is not true that both the local proxy and the web browser are being used to generate the query in Pepe, because as shown

in Fig. 5, step 54, the user begins a standard www query using the web browser (which is an application) (i.e. user input is received through execution of an application (browser)). At step 56, the local proxy (which is also an application) creates a query script setting compression (i.e. the local proxy which is also an application generates (creates) a compressed query).

Applicant alleges that "In Pepe, there is nothing to even suggest that the requests generated by local proxy 56 are compressed [,]" (p. 8, lines 1-13).This is not persuasive argument. In Fig. 5, step 56, the Lp (local proxy) creates a query script setting compress, Filters and encrypt (i.e. the Lp performs compressions, filtering and encryption of the query) and in step 66, the remote proxy unpackages the query (decompress) and performs compress, filters and encrypt data and reply to the local proxy. It is very clear that both the local and remote proxies perform compression, filtering and encryption which is the same thing as generating a compressed query.

Applicant alleges that " DeBoor does not teach or suggest that the wireless communication device generates compressed queries for data [,]" (p. 9, lines 10-21).This is not persuasive argument. Firstly, it looks like the Applicant demands that each reference should recite all the features recited by other reference to be combined i.e demands a 102 rejection. Secondly, DeBoor is combinable with Pepe because it is an analogous art in the same field. Both references perform wireless communication using a web browser.

Applicant alleges that " with respect to the rejection to group II claims 38-42 for being obvious in view of Kikinis, Pepe, and DeBoor [,]" (p. 9, line 26-p. 10, line 21).This is not

persuasive argument. Firstly, the combination of Pepe and DeBoor discloses a wireless application to receive input and to generate a compressed query. Pepe receives an end user request through a www query (Application) and a local proxy (Application) creates a query script setting compress. DeBoor in an analogous similar wireless device that uses a www browser uses a wireless application to receive a user input query. Secondly, Kikinis clearly discloses that the proxy server is connected to the wireless device shown in Fig. 1 by a satellite link (col. 5, lines 1-4) (i.e. wireless medium). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, by using a wireless application in the wireless device in order to achiever a compact, portable, hand held wireless device with improved navigational method, and by using Kikinis's teachings, by using a compact makeup language to fetch the data from the proxy server and display it in order to transform the files downloaded from the web into a form quickly and easily displayable by the wireless device and to minimize bandwidth requirements for the link and speeds transmission of data.

Applicant alleges that "First, the invention is repeatedly described as being operable on a PALM III device, which inherently requires a contact sensitive screen that detects contact as input

[,]" (p.4, lines 3-7).This is not persuasive argument. Firstly, while it is true that the specification describes that the invention is operable on a PALM III device, the specification as originally filed does not recite or suggest anywhere that PALM III device has a contact- sensitive screen that detects contact to display as claimed. Secondly, a portable or wireless device may inherently require an input means for user- input, however, it is not necessary inherent that the input means is a contact sensitive screen that detects contact. An input means could be a button set as for example in a wireless telephone or keyboard as for examples in a portable wireless computer. Thirdly, while it is true that the claims and not the specification are to determine the scope of the invention, the claims should have clear support in the originally filed specification and limitations that are not supported by the originally filed specification can not claimed.

For the above reasons, it is believed that the rejections should be sustained. Respectfully submitted,

Hieu Le

4/13/2003

Hieu Le.

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